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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,171	12/20/2000	Bruno Johannes Ehrnsperger	CM2128FQ/JH	8797

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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/720,171

Applicant(s)

EHRNSPERGER ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***New Matter Objection***

1. The amendment filed 03/19/2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the membrane permanently activated upon contact with gas and the soluble layer being dissolved upon contact with gas are nowhere found in the specification with respect of claims 14-20.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 6, 7, and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 068 830 substantially as set forth in Paper no. 6. With regard to newly added claim 12, EP'830 teaches the porous material being dry prior to use and upon contact with liquid, it permanently allows the liquid to pass there through (claim 1). With regard to claim 13, since the claimed soluble layer coated on the membrane disappears upon contact with liquid, the article of EP'830 reads on the claim limitations. With regard to claims 14-17 and 20, since EP'830 is using the same porous material having the pore size within the claimed range to form the membrane

as Applicants, functional limitations would be inherently present as set forth in the claims. Products of identical chemical composition can not have mutually exclusive properties. In re Spada, 15 USPQ 2d 1655 (1990). It is the examiner's position that EP'830 anticipates the claimed subject matter.

4. Claims 1, 3, 4, 6-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutherland (US 6,146,535). Sutherland discloses a system for separating oil from water comprising a liquid reservoir, a plurality of hydrophobic microporous hollow fibers 30 which are in communication with a pressure source 34 by a seal 32 in order to force the contaminant through the micropores thereof (figure 9). Sutherland teaches the fiber having the pore size ranging from 0.03 to 5 microns (column 10, lines 1-2), meeting the specific range required by the claims. The hydrophobic characteristic of the fiber reads on the liquid impermeability of the membrane. The sealing between the fibers and the pressure source ensures no gas passing through the fibers. Likewise, the fibers are gas impermeable. Upon the pump pressure, the oil can pass through the fiber to provide a discrete purified oil phase free of water (column 6, lines 1-10). Since the claimed soluble layer coated on the membrane disappears upon contact with liquid, the device of Sutherland on the claim limitations. Sutherland teaches a rigid mesh employed to protect the fiber (column 11, lines 23-24). The fiber permanently allowing the oil to pass there through upon contact with the aqueous medium reads on the limitation of the membrane permanently activated upon contact with liquid. Since Sutherland is using the same fibrous material having the pore size within the claimed range to

form the membrane as Applicants, functional limitations and a bubble point pressure would be inherently present as set forth in the claims. Products of identical chemical composition can not have mutually exclusive properties. In re Spada, 15 USPQ 2d 1655 (1990). It is the examiner's position that Sutherland anticipates the claimed subject matter.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 068 830 substantially as set forth in Paper no. 6.
7. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutherland (US 6,146,535). The fiber has an average pore size of 0.03 to 5 microns (column 10, lines 1-2). However, such a variable would have been recognized by one skilled in the art as dependent upon the intended use for the fiber in term of the contaminant to which it will be exposed (column 9, lines 65-66). As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fiber having the pore size instantly claimed motivated to maximize the efficiency to separate the oil from the water since it has been held that where the general conditions of a claim are

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-17 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,500,337. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons. Claims 1-12 of U.S. Patent No. 6,500,337 disclose the presently claimed subject matter except an activatable membrane. However, since claims 1-12 of U.S. Patent No. 6,500,337 using the same material to form the membrane as Applicants, functional limitations would be inherently present as set forth in the claims. Products of identical chemical composition can not have mutually exclusive properties. *In re Spada*, 15 USPQ 2d 1655 (1990). With regard to claim 13, since the soluble layer coated on the

membrane disappears upon contact with liquid, the device of claims 1-12 of U.S.

Patent No. 6,500,337 reads on the claim limitations.

***Response to Arguments***

10. The claim objections and the art rejections over EP'665 and Lawrence have been overcome by the present amendment and response.
11. The art rejections over EP'830 have been maintained for the following reasons.

The argument that EP'830 fails to teach an activatable membrane is not found to be persuasive. EP'830 discloses the liquid remains distributed throughout the porous material until expressed by squeezing the material at hand pressure (page 5, lines 5-10). Likewise, it is clearly apparent that the porous material is liquid impermeable prior to activation. Further, EP'830 teaches the porous polymer film is interposed between two layers of substrate laminate and the whole are heat-sealed together along the edge regions in a grid pattern to form a plurality of compartments 15a, 15b, each containing a square 16 of porous material carrying liquid (page 18, lines 6-11, page 28, line 28 et seq., and figures 3 and 4). In view of the heat sealing along the edge regions of the article, the porous material would not allow gas to pass through. Upon a hand pressure, the porous material allows the liquid to pass there through (page 5, lines 5-10). Thus the art rejections over EP'830 are sustained.

**Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV  
May 22, 2003

A handwritten signature in black ink, appearing to read "Terrel Morris", written in a cursive style.

TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700